UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,444	07/31/2003	Scott R. Carrier	LOT920030006US1	2867

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HOFFMAN WARNICK LLC
75 STATE STREET
14TH FLOOR
ALBANY, NY 12207

EXAMINER
LIN, WEN TAI

ART UNIT	PAPER NUMBER
2154	

NOTIFICATION DATE	DELIVERY MODE
08/19/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hwdpatents.com

	Application No.	Applicant(s)
Office Action Summary	10/632,444	CARRIER, SCOTT R.
	Examiner	Art Unit	
	Wen-Tai Lin	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>20 June 2008</u>.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-26</u> is/are pending in the application.
     4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) <u>1-26</u> is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a) ☐ All   b) ☐ Some * c) ☐ None of:
       1. ☐ Certified copies of the priority documents have been received.
       2. ☐ Certified copies of the priority documents have been received in Application No. _____.
       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-26 are presented for examination.

2.   The text of those sections of Title 35, USC code not included in this action can be found

in the prior Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

3.   Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention.

        Specifically, in the recently amended claims 1, 8, 15 and 21 Applicant added a new

feature requiring: "providing administrator access for manual amendment of an address in an

event that a valid address has not been generated by the sequence of address generation scripts,"

citing paragraph 19 of the specification as a support. It is noted that such feature is not found in

the application as filed. In fact, paragraph 19 of the specification only mentions that address

generation scripts are typically provided by an administrator; the specification does not teach or

suggest that an administrator is allowed to manually amend a script-generated address when the

address is found to be invalid. To deal with an invalid address, paragraph 29 of the specification

allows an administrator to specify "whether he/she wishes to append numeric digits to electronic

addresses in the event that a valid mail address had not been achieved through a completed

iteration of address generation scripts 14, If enabled, this option would ensure that a unique

address will be created during this process." Again, the teaching here is that an administrator can

activate an option of attaching numeric numbers on a script-generated address so as to ensure its

uniqueness. The numeric numbers are added by the system under a special mode of operation,

which is activated by an administrator, rather than manually added by the administrator.

Claim Rejections - 35 USC § 103

4.		Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stern et al.

(hereafter "Stern")[U.S. PGPub 20020032740] in view of Bliss et al. [U.S. Pat. No. 6654789].

5.		Stern was cited in the previous office action.

6.   As to claims 1-2, Stern teaches the invention substantially as claimed including: a

method for automatically generating electronic addresses of users [e.g., paragraphs 69-73],

comprising:

providing a sequence of address generation scripts, each address generation script

including a unique template that defines a structure for an electronic address [e.g., paragraphs

164-169];

determining a valid electronic address for assigning to a user by iterating through the

sequence of address generation scripts in order of which address generation script is preferred by

an organization to which the user belongs [e.g., paragraph 161; claim 3; i.e., it is clear that the

predefined common email address formats such as those shown in paragraphs 164-168 may be

arranged in an order of preference],

wherein the valid electronic address is determined when one of the address generation

scripts produces an electronic address and complies with a predetermined addressing standard

[e.g., Fig.3; paragraphs 160-171].

Stern teaches that the address generation is for marketing purposes (i.e., addresses that

already exist). Stern does not specifically teach that the electronic addresses are unique,

previously unused and are assigned to users.

However, email address generation processes for purpose of assigning a unique email

address to a user among Internet email service providers such as hotmail or yahoo's email

servers are well known in the art.

It would have been obvious to one of ordinary skill in the art to apply Stern's reverse engineering method for deducing certain preferred email address formats in the process of new email address assignment based on a user's identifier and his/her affiliation because the process systematically creates more memorable email addresses for users who supply associated information [see paragraphs 173-174 for motivation].

Further, Stern teaches validating an email address by actually sending an email to the created email address. Stern does not suggest validating an email address by checking that it is unique within the same domain server without consuming email reception resource of the organization. This is because Stern's original purpose was to create email addresses for marketing purpose, where testing whether the created email addresses would actually reach its intended targets is ultimately important.

However, Bliss teaches a method of creating and validating email addresses by testing its uniqueness within a registered domain [e.g., col.2, lines 40-59]. It would have been obvious to an ordinary skilled artisan who tries to make use of Stern's reverse engineering method to create new email addresses <u>for a company or ISP associated mailboxes</u> would recognize that the so created email addresses must undergo Bliss' uniqueness test (e.g., by comparing with the existing email addresses held in a database) because it is a common sense not to assign a same email address to more than one person.

7.   As to claim 3, Stern further teaches that the user data is provided from a repository [e.g., paragraph 69 and claim 5; i.e., a database] and wherein the sequence of address generation

scripts are generated by an administrator [e.g., paragraph 163; it is noted that rules such as those listed in paragraphs 164-170 are typically generated by an expert user such as an administrator].

8.   As to claim 4, Stern further teaches that the determining step comprises:

generating a first electronic address according to a first one of the sequence of address generation scripts; and testing the first electronic address to determine if the first address is unique [e.g., paragraph 66] and complies with a predetermined addressing standard [e.g., paragraph 171].

9.   As to claims 5 and 7, Stern teaches using predetermined addressing standard to form the email addresses. Therefore the resulting addresses are inherently compliant with the intended standard.

Further, Stern teaches resolving duplicate information stored in the database in general. Stern does not specifically teach resolving duplicates by comparing the generated electronic address against those previously created electronic addresses and that the set of previously created electronic addresses are stored in an electronic address repository.

However, resolving duplicates by the aforementioned comparison method is well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to test each of Stern generated email addresses by comparing newly generated address against the existing addressed and storing the previously created electronic addresses in an electronic address repository because the former is a popular and efficient approach to achieve

uniqueness, while the latter facilitate access of the existing addresses when performing

comparison.

10.   As to claim 6, Stern further teaches that the set of previously created electronic addresses

are stored in a repository with user data corresponding to the user [e.g., claim 18].

11.   As to claims 8-26, since the features of these claims can also be found in claims 1-7, they

are rejected for the same reasons set forth in the rejection of claims 1- 7 above.

12.   Applicant's arguments filed on 6/20/08 for claims 1-26 have been fully considered but

they are not deemed to be persuasive.

In addition to the added features to claims 1, 8, 15 and 21, which has been rejected under

USC 112 first paragraph (see item #3 of this instant office action), Applicant further argues that

Stern and Bliss in view of Yahoo or hotmail's email address generation does not render claim 1

obvious (specifically to the features of assigning email user names based on user-defined

templates) because Stern's reverse engineering involves deconstruction of pre-existing email

addresses, Bliss teaches checking for uniqueness, and Yahoo or hotmail normally allow the user

to choose an electronic address, which the provider later validates. That is, these three different

teachings do not logically combine to yield the features of claim 1.

13.   As an initial matter, Applicant is reminded that claim 1 does not require that the address

generated for a user be "based on user-defined templates." That is, the user who is assigned a

template-generated address does not involve in the template definition.

In response to the arguments, Applicant is reminded that almost all users of mailbox

providers (such as Yahoo and Hotmail) have gone through the process of entering an electronic

address of their choice first. The system then validates the chosen address. If it does not come up

with a unique address, the system typically make one or more proposed valid email addresses for

the user to choose. These proposed email addresses typically use characters extracted from the

users' names (for ease of remembering), followed by a numeric number (for ensuring its

uniqueness). From the format of these automatically generated email addresses, one could easily

find that these email addresses are generated according to certain predetermined templates or

rules, which are similar to the "preferred rules" listed in Stern's paragraphs 164-169, except for

the attached numeric number.

While it is sufficient for an ordinary skilled artisan to learn and adopt the various implicit

rules/templates associated with the process of mailbox providers' email address generators, the

Stern reference conveniently provides explicit teachings of using the same. In fact, Stern teaches

two aspects of rule derivation: one through reverse-engineering of pre-existing addresses and the

other through the choice of the so called "preferred rules" in paragraphs 164-169. It is noted that

Stern's reverse-engineering method serves only an example of rule derivation. The rejection of

claim 1 solely rely on Stern's teaching of template/rule-based address generation and an ordinary

skill who may not see the implicit rules/templates from the mailbox providers' email address

generator would certain learn the same from Stern's teachings. As for uniqueness, it is a common

sense to require a generated address to remain unique within the same domain. The Bliss

reference provides an explicit teaching toward a checking process for such purpose. An ordinary

skilled artisan who may not see the implicit requirement from the mailbox providers' email

address generator would certain learn the same from Bliss' teachings.

For at least the foregoing reasons, it is submitted that the prior art of record read on

claims 1-26.

14.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

15.   A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR

1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

Conclusion

Examiner note: Examiner has cited particular columns and line numbers in the references as

applied to the claims above for the convenience of the applicant. Although the specified citations

are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

August 14, 2008

/Wen-Tai Lin/

Primary Examiner, Art Unit 2154